

Claim Objections:

Claim 58 is objected to under 37 CFR 1.75 (c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claims(s) in independent form. Claim 57 claimed “translating said tones or pulse into said instructions that can control a specific device located at a remote location” and claim 58 claimed “translating said tones or pulse into instructions. The claim 58 failed to further limit the subject matter of claim 57. Claim 58 has been corrected. Claim 58 is allowable.

Claim 59 is objected to because of the following informalities: the claim preamble states a “method” claim while the claim body claimed “mean”. Appropriate correction is required. Appropriate changes have been made, is now a method claim. Claim 59 is allowable.

Claim 60 - Claim 66 are allowable as dependent of allowed claim 59

Claim 67 recites “the desired device” (line 3). There is insufficient antecedent basis for this limitation in the claim. Appropriate changes have been made. Claim 67 is allowable.

Claim 68 is objected to because of the following information: Claim 68 depends on Claim 12 which is a cancelled claim. Appropriate correction is required. Claim 68 was

appropriately changed. Claim 68 is allowable.

Claim 80 recites “the position” (line 2), “the relative position” (line 3). There is insufficient antecedent basis for this limitation in the claim. Appropriate changes were made to the claim. Claim 80 is allowable.

Claim 81 recites “the information from a remote input terminal”. There is insufficient antecedent basis for this limitation in the claim. Claim 81 was corrected. Claim 81 is allowable.

Claim 82 - Claim 87 are allowable as dependent of allowed claim 81

Claims 85, 86 and 100 recites “the transmitter”, “said tones or pulse”, “said incoming instructions”. There is insufficient antecedent basis for this limitation in the claim. Claim 85, 86, and 100 were corrected. Claim 85, 86, and 100 are allowable.

Claim Rejections - 35 USC § 112

Claim 59 (and other claims where the same rejected limitation is claimed) is rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “receiving one or more tones or pulse” is not clearly defined. It is unclear the “tones or pulses” are mutually exclusively received at the same time or are mutually inclusively received at the same time. This has been corrected. Claim 59 is

allowable.

Claim 60 - Claim 66 are allowable as dependent of allowed claim 59

Claim 67 is rejected under USC 35 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "it" (line 5 and line 13) is not clearly defined. It is unclear the "it" refers to "a means" (line 4) or "central computer" (line4), or "incoming communication" (line 4), or other. Also, the claim "said incoming communications" (plural) is not clearly defined. Claim 67 claimed, in line 4, "incoming communication" (singular). This has been corrected. Claim 67 is allowable.

Claim 68 is allowable as dependent of allowed claim 67

Claim 69 is allowable as dependent of allowed claim 67

Claim 68 is rejected under USC 35 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "a means for both the central computer and the remote location to instructional information ... Communication network" is not clearly defined. The Examiner cannot understand the claimed language. Claim 68 has been appropriately corrected. Claim 68 is allowable.

Claim 69,72, 80,and 107 are rejected under USC 35 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "position of said tones or pulse" is

not clearly defined. It is unclear the “position” refers to “a location” (for example, on a user device, or on a server, or in a particular work place) or others. Claim 69, 72, 80, 107 has been appropriately corrected. Claim 69, 72, 80, 107 are allowable.

Claim 69 is allowable as dependent of allowed claim 67

Claim 72 is allowable as dependent of allowed claim 70

Claim 78 is rejected under USC 35 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “incoming instructions a memory” is not clearly defined. The Examiner cannot understand what is “incoming instructions a memory”. Claim 78 has been appropriately corrected. Claim 78 is allowable.

Claim 79 is allowable as dependent of allowed claim 78

Claim 80 is allowable as dependent of allowed claim 78

Claim 80 is rejected under USC 35 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “the processor” (line3) is not clearly define. It is unclear the claimed “the processor” refers to “a processor” (line 3 claim 78) or “a processor” (line 1 claim 80). Claim 80 has been appropriately corrected. Claim 80 is allowable.

Claim 81 is rejected under USC 35 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. The phrase “able to receive” is not clearly defined. It is unclear that the “a processor” is able to receive or “a remote location” is able to receive. Also, the claimed “them” (line 16) is not clearly defined. It is unclear what the claimed “them” refers to. Claim 81 has been appropriately corrected. Claim 81 is allowable.

Claim 81 - Claim 87 are allowable as dependent of allowed claim 81

Claim 91 is rejected under USC 35 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “the communication system is off hook” is not clearly defined. To one skilled in the art the “off hook” may refer to a telephone set. It is unclear what does it mean “the communication system is off hook”. Claim 91 has been appropriately corrected. Claim 91 is allowable.

Claim 56 is rejected under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use this invention. The phrase “determining whether a communication system located at a remote location is able to accept instructions from a central computer” is not disclosed by the specification. The specification disclosed on line 21-22 page 39, the router (claimed “a communication system location”) determines if the DTMF (instructions from the user device) should be accepted based on the access code. The specification did not support “determining a communication system is able to accept from a central computer.” A review of paragraphs [0074], [0075], Position Table, and Content Table will clearly show

that the applicant did provide sufficient specification in the patent application for explaining how the remote device can determine if instructions from a central computer should be accepted. In [0074], the Applicant discloses "In one embodiment, the central site validates the user's identity and collects information regarding the program the user wants to record: day of recording, time of the recording, channel from which to record the program. The central site then generates a string of DTMF tones that encodes the user's access code, channel from which the recording is to be made, the commands to activate the VCR, the commands for rewinding the tape, and the commands for start recording."

In [0075], the Applicant discloses "EA router 120A, in this embodiment, recognizes that the central site sends a string of DTMF tones in a predetermined format. This allows the EA router 120A to convert the captured DTMF tone sequence into a numeric string that can be segmented into both remote control command codes and access codes. The access codes allows the EA router 120A to recognize that the instructions come from an authorized VCR user. The command codes allows the EA router 120A to turn on the VCR, rewind the tape in the VCR, select the channel to record and then start recording."

The Applicant clearly illustrate that an access code will be provided by the central computer, and that the access code is required for having the programming instructions passed to the device located at the remote location. The Applicant also illustrates the position and contents of a access code passed to the remote site from a central computer. In [0019], the Applicant's discloses "FIG. 2 illustrates one embodiment of the router 120 used in the system shown in FIG. 1. The main components of the automatic call router 120 are a sensor array 122, relays 130, stamp 124 (containing a microprocessing unit,

EEPROM, clock and RAM memory), ...". In [0027], the Applicant discloses "A stamp 124 is employed by router 120 and comprises a PIC-micro-controller chip (microprocessor), PBasic interpreter chip (software language use to program the micro-controller), EEPROM (electrically erasable programmable read only memory), RAM (Random Access Memory), clock and ports through which information and instructions can be passed. In this embodiment these ports are called pins, and each pin". The present of memory for storing executable code, and a microprocessor to processing said code, is all that is needed for a person skilled in the art of programming to set up a password / access code checking routine in the EA-Router. The access code checking routine would guard a remotely located VCR from un-authorized access / programming. Claim 56 is allowable.

Claim 57 and Claim 58 are allowable as a dependent of an allowed claim 56

Cited Material Used In Patent Defense:

1.

[HN3] Anticipation is a question of fact. In order to anticipate, there must be identity of invention; thus, the claimed invention, as described in appropriately construed claims, must be the same as that of the reference. More specifically, under 35 USCS 102 (b), a patent claim is anticipated by a prior art reference if the reference discloses, either expressly or inherently, each and every element of the claimed patent. Every element of a claimed invention must be identically shown in a single reference for a prior art reference to anticipate. (Danny J. Elder and Enviro-Stain, Inc. Plaintiffs, v A.S.Tanner

and Tanner Forest Products, Corp., Defendants; Case No. 1:98-CV-36; United States District Court For the Eastern District Of Texas, Beaumont Division; 180 F. Supp. 2nd 818; 2001 U.S. Dist. LEXIS 23054)

2.

[HN31] The test of obviousness in 35 U.S.C.S. § 103 is the primary condition of patentability. Obviousness hinges on four factual findings: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. Metabolite laboratories, Inc. and Competitive Technologies, Inc., Plaintiffs-Appellees, v Laboratory Corporation Of America Holding (doing business as LabCorp), Defendant-Appellant. United State Court Of Appeals For The Federal Circuit 2004 U.S. App. LEXIS 11248

3.

[HN1] The presumption of patent validity must be overcome by clear and convincing evidence, and the patents commercial success and the failure of competitors to develop equally successful inventions are important factors weighting in favor of the validity of the pates. In addressing the question of obviousness, a judge must not pick and choose isolated elements from the prior art and combine them so as to yield the invention in question if such a combination would not have been obvious at the time of the invention.

*475 US 809, *; 106 S. Ct. 1578, **;*

*89 L. Ed. 2d. 817, ***; 1986 U.S. LEXIS 100*

DENNISON MANUFACTURING CO. V. PANDUIT CORP.

No. 85 – 1150

SUPREME COURT OF THE UNITED STATES

*475 US 809, *; 106 S. Ct. 1578; 89 L. Ed. 2d. 817; 1986 U.S. LEXIS 100; 54 U.S.L.W.
3695; 229 U.SP.Q. (BNA) 478; 4 Fed. R. Serv. 3d (Callaghan) 366*

4.

1. *535 F2d 67 *; 1976 CCPA LEXIS 162, **; 190 U.S.P.Q. (BNA)15*

*IN THE MATTER OF THE APPLICATION OF MAMORU HIRAO AND YOSHINORI
SATO*

Patent Appeal No. 76-560

UNITED STATES CORT OF CUSTOMS AND PATENT APPEALS

MAY 27, 1976 DECIDED

*In “Hirao” it reads on a patent can contain both unique and obvious components, so
long as these component are applied in a unique manner they are patentable.*